

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 7,488,734 Issued: February 10, 2009

Appln. No. : 10/601,438 Filed: June 23, 2003

Applicant : Fensome et al Conf. No.: 7149

TC/A.U. : 1617

Examiner : Hui, San-ming

Customer No. : 38199

Title : METHODS OF TREATING HORMONE-RELATED CONDITIONS
USING THIO-OXINDOLE DERIVATIVES

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR DEFERRAL OF RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 CFR §1.705(d)

Dear Sir:

Patentees respectfully request that consideration of, and a decision regarding, their Application for Patent Term Adjustment be held in abeyance, pending a final, non-appealable, decision on the merits in *Wyeth v. Dudas*, 07-CV-1492 (D.D.C), on appeal, 2009-1120 (Fed. Cir.)("Wyeth v. Dudas").

1. Patentees filed an Application for Patent Term Adjustment including Request for Reconsideration under 37 CFR §1.705(d) on April 3, 2009.

2. Wyeth (an Assignee of this patent) and Elan Pharma International Limited filed a civil action in the United States District Court in and for the District of Columbia against Jon W. Dudas, as Under Secretary of Commerce for Intellectual Property and Director of the USPTO

(07-CV-1492 (D.D.C.)). This case is on appeal to the United States Court of Appeals for the Federal Circuit (Wyeth v. Dudas, 2009-1120).

3. Wyeth v. Dudas relates to the interpretation of 35 USC §154, and in particular, the interrelation of 35 USC §§154(b)(1)(A) and (b)(1)(B).

4. Patentees' Application for Patent Term Adjustment is based on an interpretation of 35 USC §154, which is the subject of Wyeth v. Dudas. *See* Statement of Facts Accompanying Request for Reconsideration of Patent Term Adjustment, filed April 3, 2009, at paragraph 3.(B) and (C).

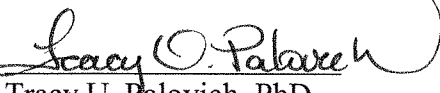
5. A proper determination regarding Patentees' Application including Request cannot be made, given that a final non-appealable decision on the merits in Wyeth v. Dudas will have collateral estoppel effect on the USPTO.

In view of the above, Patentees respectfully request that consideration of, and a decision regarding, their Application for Patent Term Adjustment including Request for Reconsideration under 37 CFR §1.705(d) be deferred until a final non-appealable decision on the merits in Wyeth v. Dudas.

Respectfully submitted,

HOWSON & HOWSON LLP

Dated: 8/21/09

By 
Tracy U. Palovich, PhD
Registration No. 47,840
501 Office Center Drive
Suite 210
Fort Washington, PA 19034
Phone: (215) 540-9200
Facsimile: (215) 540-5818